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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/913,717 | 08/17/2001 | Hiroki Nakamura | 2121638US0PCT | 2975 |

22850 7590 07/01/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PEZZUTO, HELEN LEE

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1713

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/913,717 | NAKAMURA ET AL. | |
| | Examiner | Art Unit | |
| | Helen L. Pezzuto | 1713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/17/01 and 12/11/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/17/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/19/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1713

DETAILED ACTION

The amendment to claim 1 and the cancellation of claim in filed in the preliminary amendment on 8/17/01 are acknowledged. Currently, claims 1, and 3-6 are pending in this application.

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 625 541 A2.

EP-541 discloses a process for controlling adsorption of polymeric latex on titanium dioxide

Art Unit: 1713

wherein a dispersion of polymeric latex particles having at least one dihydrogen phosphate functional group is employed. Suitable dihydrogen phosphate esters include those encompassed in the instant formula (1) (page 6, lines 48-52; page 7, lines 7-12; page 8, line 56 to page 9, line 23; working examples). The instant optional comonomers (b) and (c) are also disclosed. Prior art teaches in a preferred embodiment that the selected polymeric latex has a relatively low effective glass transition temperature of from -50°C to 20°C, which embraces that expressed in claim 1. Prior art is silent regarding the vibration-damping capability and properties recited in claims 3-6. The examiner is of the position that such function/property, though not explicitly shown by the reference, are inherent characteristics in prior art composition because identical components are produced in the claimed proportions. The burden is upon the applicant to provide clear and convincing evidence that the respective composition do in fact differ. Furthermore, such evidence must be commensurate in scope with the recited claims.

Claim Rejections - 35 USC § 102

Art Unit: 1713

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Inaishi et al (Die Makromol. Chem., 176, 2473-2478(1975)) or Kimura et al. (Die Makromol. Chem., 176, 1945-1951 (1975)) or EP 0 765 889 A1 or EP 0177 139 or GB 2 218 708 A or Yasuda et al. (US 5,534,398) or WO 97/28225 or Nair et al. (J. Polym. Sci, Part A, 26(7), 1791-1807, 1988)

Inaishi et al. disclose the synthesis and polymerization of 10-[bis(benzyloxy)phosphoryloxy]decyl methacrylate, which embraces the scope of the phosphate monomer expressed in claim 6.

Kimura et al. Disclose the synthesis and polymerization of benzyl 2-(Methacryloyoxy)ethyl hydrogen phosphate, which embraces the definition of the phosphate monomer recited in claim 6.

EP 0 765 889 discloses a polymeric adhesive composition, comprising an acrylate monomer and 0.5%

Art Unit: 1713

to 60% of an alkylene acrylate phosphate monomer, which falls within the scope of the instant phosphate monomer expressed in claim 6.

EP 0 177 139 discloses an electroconductive material comprising at least 3 wt% of a phosphate-containing unsaturated monomer (page 5, line 3 to page 6, line 7). The polymerization of 3-hydroxypropylmethacryloyl phosphate was exemplified in Example 1.

GB 2 218 708 discloses the synthesis of homopolymer or copolymer of a phosphate-containing unsaturated monomer (page 3, line 10 to page 5, line 23; page 8, lines 6-17; page 13, line 23 to page 14, line 20; working examples).

Yasuda et al. (US-398) discloses a silver halide emulsion layer comprising an admixture of a color coupler and a phosphate-containing polymer (col. 3, line 35 to col. 10, line 36) which embraces the instant phosphate monomer expressed in claim 6.

WO 97/28225 discloses an acrylic resin composition comprising a phosphoric ester or a phosphonic ester monomer shown in formula (1) and (2). Preferred phosphate monomer disclosed fall within the

Art Unit: 1713

scope of the instant phosphate monomer defined in claim 6 (pages 5-7); working examples 1 and 4).

Nair et al. the copolymerization of diethyl 2-(methacryloyloxy) ethyl phosphate with alkyl acrylates, which embraces the phosphate monomer expressed in claim 6.

Prior art composition discussed above anticipate that recited in claim 6 for the reasons stated. Furthermore, the examiner takes the position that the intended use for vibration-damping material expressed in the preamble is not afforded the effect of a distinguishing limitation, because the body of the claim does not set forth limitation that refers to the environment or use specified in the preamble.

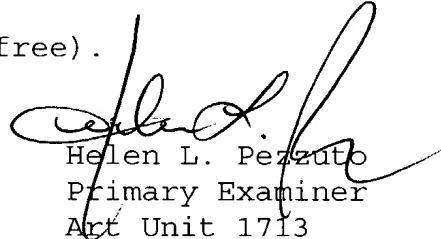
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the

Art Unit: 1713

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helen L. Pezzuto
Primary Examiner
Art Unit 1713

hlp